

RECEIVED
CENTRAL FAX CENTER

MAR 19 2007

PATENT APPLN. NO. 10/646,810
SUBMISSION UNDER 37 C.F.R. § 1.114

PATENT

REMARKS

In the Advisory Action dated March 9, 2007, the Office has maintained the rejection of claims 1 to 16 under 35 U.S.C. 103(a) as being unpatentable over Iwamoto et al. (U.S. Patent Publication No. 2002/0039677 A1; hereinafter "Iwamoto") made in the Final Office Action dated October 19, 2006.

In the rejection, the Office states that the tetrahydrofuran carbonate additive of Iwamoto shares a close structural similarity with the tetrahydrofuran wettability improving agent of the present application and that a person of ordinary skill in the art would expect the two compounds to exhibit similar properties in a lithium secondary battery. The Office cited Ishiiyoda et al. (U.S. Patent No. 5,660,937) as evidence that the two compounds are Lewis bases. The position of the Office is that it would have been obvious to use tetrahydrofuran in the battery of Iwamoto based on the alleged expectation of a person of ordinary skill in the art that tetrahydrofuran would exhibit the same properties as tetrahydrofuran since both compounds are Lewis bases with a similar structure.

In the response filed February 20, 2007, applicants argued that an alleged equivalence of tetrahydrofuran carbonate for tetrahydrofuran in a lithium battery based on a similar structure

and a single common property as Lewis bases fails to support a case of obviousness under 35 U.S.C. 103(a). Applicants also argued that a person of ordinary skill in the art would not be able to reasonably predict the functional equivalence of tetrahydrofuran carbonate and tetrahydrofuran in the battery of Iwamoto in view of the unpredictability of the decomposition of tetrahydrofuran carbonate.

In the Advisory Action of March 9, 2007, the Office stated that the response was insufficient to rebut the Office's position. The Office took the position that "[t]he Applicants have to show that the products resulted from tetrahydrofuran carbonate in contrast to tetrahydrofuran would have a dramatic difference."

Applicants respectfully submit that the Office has not sufficiently supported a case of *prima facie* obviousness of the claims of the present application under 35 U.S.C. § 103(a) such that the burden shifts to applicants to rebut the position of the Office. The position of the Office clearly ignores the provisions of MPEP § 2144.06 and is otherwise improper. Notwithstanding such impropriety, applicants, in order to advance the prosecution of this application, have amended claim 1 to delete tetrahydrofuran (THF) and 2-methyltetrahydrofuran (2-MeTHF) from the group of wettability improving agents.

PATENT APPLN. NO. 10/646,810
SUBMISSION UNDER 37 C.F.R. § 1.114

PATENT

Removal of the 35 U.S.C. 103(a) rejection of the claims is believed to be in order and is respectfully requested.

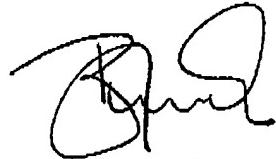
The foregoing is believed to place this application in condition for allowance. If, however, minor issues remain that can be resolved by means of a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number indicated below.

In the event that this paper is not considered to be timely filed, applicants hereby petition for an appropriate extension of time. The fee for any such extension may be charged to our Deposit Account No. 111833.

In the event any additional fees are required, please also charge our Deposit Account No. 111833.

Respectfully submitted,

KUBOVCIK & KUBOVCIK



Ronald J. Kubovcik
Reg. No. 25,401

Atty. Case No. SNY-039
The Farragut Building
Suite 710
900 17th Street, N.W.
Washington, D.C. 20006
Tel: (202) 887-9023
Fax: (202) 887-9093
RJK/jbf